

REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

Drawings

The Examiner has objected to the drawings for not showing a feature as described in claim 10. In response, the applicant has amended claim 10 by replacing the expression:

"desired transmit power signal"

with the expression:

"combination of a peak to average power ratio signal and a desired average transmit power signal"

Support for this amendment is found, for example, in claims 1 and 2 as originally filed. The feature recited by claim 10 is shown in FIG. 4 by element 185. Based on the above, reconsideration of the objection is respectfully urged.

Rejection Under 35 USC § 112

The Examiner has rejected claims 17-21, 23, 24 and 30-35 because the recitation of a "desired transmit power signal" is not described in the written description. In response to the rejection, the applicant has amended independent claims 17 and 30 to recite, in part, a "desired average transmit power signal". Support for these amendments is found, for example, in paras 0027 and 0034 and in claims 18 and 19. Accordingly, claims 18 and 19 have been canceled. Based on the above amendments, reconsideration of the rejection is respectfully urged.

Rejection Under 35 USC § 103

The Examiner has rejected claims 1 and 5-10 as being unpatentable over Petsko (U.S. Patent No. 6,535,066) in view of Ramesh (U.S. Patent No. 6,205,127) and Jeong (U.S. Pub. No. 2002/0080887). The applicant respectfully disagrees.

The Office Action was issued following the United States Supreme Court's decision in the case of KSR Int'l Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007). In light of the KSR decision, Applicant wishes to address various issues pertaining to a proper analysis under section 103.

The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base rejection upon a teaching, suggestion or motivation to select and combine features from the cited references. Applicant wishes to point out that the Supreme Court's KSR decision did not reject use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis, characterizing the analysis as "a helpful insight." KSR slip op. at 14-15.

When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with evidence and reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover, the prior art must suggest the desirability of the combination, not merely the feasibility. In re Fulton, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

Although the Supreme Court did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible analysis of an obviousness question. Because of the Examiner's chosen ground for rejection, however, the only pending ground for rejection must be a "teaching, suggestion or motivation" analysis. In the event that the Examiner chooses to consider a different avenue for rejection, this would be a new ground for rejection not due to any action by Applicant. Applicant has a right to be heard on any new ground for rejection.

Applicant further respectfully reminds the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicant is

entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

In the event that the cited references fail to disclose or suggest all of the elements recited in the claims, then combining elements from the references would not yield the claimed subject matter, regardless of the extent of any teaching, suggestion or motivation.

Independent claim 1 recites a mapping function that maps a "combination of a peak to average power ratio signal and a desired average transmit power signal". In contrast to claim 1 of the present application, there is no suggestion in Petsko, Ramesh or Jeong, alone or in combination, that a desired average transmit power signal is combined with a peak to average power ratio signal. Ramesh suggests that signal quality may be measured by "average power". However, there is no disclosure in Ramesh, or the other cited references, of a "**desired** average transmit power". The person skilled in the art would understand that "average power" and "desired average transmit power" are very different elements. As described at paras 0027 and 0028 in the application, a "desired average transmit power" is determined by using, for example, an open or closed loop power control method; it is not simply the average power of the transmit signal. On this basis, no combination of Ramesh and Petsko would lead the person skilled in the art to the transmitter recited by claim 1.

Furthermore, Petsko discloses that the signal quality measurement (36) is an **input** into the selection means (28). There is no disclosure or suggestion in Petsko, or the other cited references, that the signal quality measurement could be **combined** with the "peak to average power ratio signal" as recited by claim 1. In fact, Petsko states that "the signal quality may be determined by detecting excessive requests to resend data". The person skilled in the art would understand that this information could **not** be usefully combined with the "peak to average power ratio signal". Thus, Petsko also teaches away from combining the signal quality with the peak to average power ratio signal. On this additional ground, claim 1 and claims 5-10, dependent thereon, would not have been obvious in light of any combination of the cited art. Reconsideration of the rejection is therefore respectfully urged.

The Examiner has also rejected claims 17-21, 23 and 24 as being unpatentable over Petsko in view of Ramesh and Jeong. The applicant respectfully disagrees for reasons similar to those submitted above with respect to claim 1. Amended independent claim 17 now recites a

mapping function that maps a "desired average transmit power signal or a combination of a peak to average power ratio signal and a desired average transmit power signal". In contrast to claim 17, there is no disclosure in Ramesh, or the other cited references, of a "**desired average transmit power**". The person skilled in the art would understand that "average power" of Ramesh and "desired average transmit power" are very different elements. As described at paras 0027 and 0028 in the application, a "desired average transmit power" is determined by using, for example, an open or closed loop power control method; it is not simply the average power of the transmit signal. On this basis, no combination of Ramesh and Petsko would lead the person skilled in the art to the transmitter recited by claim 17.

Furthermore, Petsko discloses that the signal quality measurement (36) is an **input** into the selection means (28). There is no disclosure or suggestion in Petsko, or the other cited references, that the signal quality measurement could be the **only** input or be **combined** with the "peak to average power ratio signal" as recited by claim 17. On this additional ground, claim 17 and claims dependent thereon would not have been obvious in light of any combination of the cited art. Reconsideration of the rejection is therefore respectfully urged.

The Examiner has rejected claims 25-27 as being unpatentable over Petsko in view of Ramesh and Jeong and Bartl (U.S. Application No. 2003/0176202). Responsive to the objection, the applicant has amended independent claim 25 by replacing the term "desired transmit power" with the term "desired average transmit power". Support for this amendment is found, for example, at paras 0027 and 0028. The applicant respectfully submits that amended claim 25 is now distinguished over Petsko, Ramesh and Jeong for the reasons stated above with respect to claim 17. There is also no suggestion in Bartl of a "**desired average transmit power**" as recited by claim 25. Thus, claim 25 and claims dependent thereon would not have been obvious in light of any combination of the cited art. Reconsideration of the rejection of claims 25-27 is therefore respectfully urged.

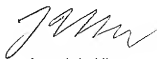
In view of the above, elements recited in the claims are not disclosed by the cited references, and thus the person skilled in the art could not produce the claimed invention by combining the references.

The applicant further submits that the Examiner has not provided reasoning for combining the claims as indicated. In Ruiz v. A.B. Chance Co., 234 F.3d 654, 660 (Fed. Cir. 2000) the

appellate court stated that the motivation must "clearly and particularly" lead one of ordinary skill in the art to make a combination. With regards to Jeong, the examiner merely suggests that "it would have been obvious to a person of ordinary skill in the art to implement the limitation taught by Jeong" or similar general statements without reason. With regard to Ramesh, the Examiner's support for combining this reference with Pletsko is merely a general recitation of the advantages of each patent individually and no reasoning is provided for why those skilled in the art would combine the references. In other words, the Examiner's stated rationale is unrelated to Pletsko, unrelated to the situation identified in the patent application, unrelated to any problem addressed by the Applicant's disclosure. In KSR, the Supreme Court said that the reason for combining should be known in the field of art and "addressed by" the inventor's disclosure. KSR, slip op. at 16.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favourable reconsideration and allowance is respectfully urged.

Respectfully submitted,
MOFFAT & CO.



Joseph L. Ulvr
Registration No. 57696
JLU:IK;jh 195322